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PATENT APPLICATION

ATTORNEY DOCKET NO.   10991381-1

IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s):   Masumi Senoo

Confirmation No.: 7749

Application No.:09/506,407

Examiner: S.E. Dehkordy

Filing Date: Feb. 17, 2000

Group Art Unit: 2626

Title: Configurable Printer Menu Structure

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TRANSMITTAL OF APPEAL BRIEF

Sir:

Transmitted herewith is the Appeal Brief in this application with respect to the Notice of Appeal filed on   **Mar. 21, 2005**   .

The fee for filing this Appeal Brief is (37 CFR 1.17(c)) $500.00.

(complete (a) or (b) as applicable)

The proceedings herein are for a patent application and the provisions of 37 CFR 1.136(a) apply.

( ) (a) Applicant petitions for an extension of time under 37 CFR 1.136 (fees: 37 CFR 1.17(a)-(d) for the total number of months checked below:

( )	one month	$120.00
( )	two months	$450.00
( )	three months	$1020.00
( )	four months	$1590.00

( ) The extension fee has already been filled in this application.

(X) (b) Applicant believes that no extension of time is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

Please charge to Deposit Account **08-2025** the sum of   ___$500.00___ .   At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 08-2025 under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees. A duplicate copy of this sheet is enclosed.

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Respectfully submitted,

Masumi Senoo
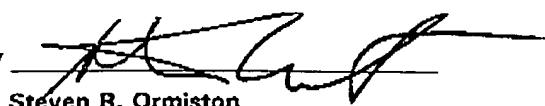
By _____
Steven R. Ormiston

Attorney/Agent for Applicant(s)

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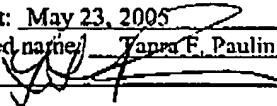
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application Serial No. 09/506,407
Filing Date .... February 17, 2000
Inventor .... Senoo et al.
Group Art Unit 2626
Examiner .... Ebrahimi-Dehkordy Saeid
Attorney's Docket No. 10991381-1
Confirmation No. 7749
Title: Configurable Printer Menu Structure

APPELLANTS'/APPLICANTS' OPENING BRIEF ON APPEAL

1.   REAL PARTY IN INTEREST.

The real party in interest is Hewlett-Packard Development Company, LP, a limited partnership established under the laws of the State of Texas and having a principal place of business at 20555 S.H. 249 Houston, TX 77070, U.S.A. (hereinafter "HPDC"). HPDC is a Texas limited partnership and is a wholly-owned affiliate of Hewlett-Packard Company, a Delaware Corporation, headquartered in Palo Alto, CA. The general or managing partner of HPDC is HPQ Holding, LLC.

2.   RELATED APPEALS AND INTERFERENCES.

There are no other appeals or interferences known to Appellants, Appellants' legal representative or the Assignee which will affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

3.   STATUS OF CLAIMS.

Claims 1-20 are pending. The rejections of all pending claims are appealed.

4.   STATUS OF AMENDMENTS.

All amendments have been entered. No amendments were filed after the final action.

5.   SUMMARY OF CLAIMED SUBJECT MATTER.

Claim 1 recites a method that includes creating a printer menu structure (Figs. 4-5; Fig. 6, steps 240-252; Specification, page 7, line 11 through page 10, lines 26) and installing the printer menu structure on an erasable storage device in the printer (Fig. 2, EEPROM 122 and RAM 124; Fig. 6, steps 254-256; Specification, page 10, line 26-page 11, line 4).

Claim 11 recites a printer that includes: a display panel (Fig. 2, display panel 134; Fig. 4) to display a plurality of menu elements (Figs. 4-5; Specification, page 7, line 11 through page 9, line 15); a user interface (Fig. 2, user interface and menu browser 132) coupled to the display panel to allow a user to select among the plurality of menu elements; and a data communication interface (Fig. 2, network interface 128 and serial/parallel interface 130) coupled to the display panel to allow the printer to receive a printer menu structure (Figs. 4-5; Specification, page 7, line 11 through page 9, line 15; Fig. 6, steps 254-256; Specification, page 10, line 26-page 11, line 4) from a remote device (Fig. 3, workstation 106).

Claim 16 recites one or more computer-readable media having stored thereon a computer program (Fig. 8, menu editor 308, menu installer 318 and menus 316) for creating a printer menu structure (Figs. 4-5; Fig. 6, steps 240-252; Specification, page 7, line 11 through page 10, lines 26) and installing the printer menu structure on an erasable storage device in the printer (Fig. 2,EEPROM 122 and RAM 124; Fig. 6, steps 254-256; Specification, page 10, line 26-page 11, line 4).

6.   GROUNDS FOR REJECTION TO BE REVIEWED.

A.   Boldt (6349304) does not teach creating a printer menu structure and installing the menu structure on the printer (Claims 1-10 and 16-20).

B.   Boldt does not teach a printer having a data communication interface coupled to the printer display panel to allow the printer to receive a printer menu structure from a remote device (Claims 11-15).

C.   Hanson (6148346) does not teach that installing the printer menu structure replaces any menu structure previously installed on the printer (Claims 2 and 17) or installing the printer menu structure extends any menu structure previously installed on the printer (Claim 3).

7.   ARGUMENT.

A.   Ground For Rejection A (Claims 1-10 and 16-20) -- Boldt does not teach creating a printer menu structure and installing the menu structure on the printer.

Claims 1-10 and 16-20 were rejected under Section 103 as being obvious over Boldt (6349304) in view of Hanson (6148346). The rejection is based on the assertion that Boldt teaches creating a printer menu structure and installing the menu structure on the printer. Applicants respectfully submit that this assertion is not correct.

Claim 1 recites creating a printer menu structure and installing the printer menu structure on an erasable storage device in the printer. Claim 16 is a programming counterpart to method Claim 1 and contains similar limitations. The Examiner argues that Boldt discloses creating and installing a printer menu structure at column 3, lines 49-60, column 6, lines 38-63 and column 7, lines 1-27.

Applicants note at the outset, respectfully but with much frustration, that more and more Examiners seem to have gotten in the habit lately of supporting a rejection by the simple expedient of quoting the claim limitations and then citing to passages in a reference. No effort is made to explain how the language in the cited passages might reasonably be deemed to teach the limitations. And so it is in this case. The passages in Boldt relied on by the Examiner are quoted verbatim below -- there is nothing apparent in these passages that teaches or suggests creating and installing a printer menu structure. Indeed, a printer menu is not even mentioned.

> "Each printer 8a, b, c, d in the network 2 is capable of implementing particular features and has those features configured to specific values or settings. The feature offered at any one printer 8a, b, c, d and configuration of those features may vary throughout the network 10. Preferred embodiments allow a network administrator or other user to use a computer 4a, b, c, d to configure features with values within printers 8a, b, c, d throughout the network. Some of the features the computer 4a, b,

c, d may configure with values within network printers 8a, b, c, d via the network 10 include...." Boldt, column 3, lines 49-60.

* * *

"FIG. 3 illustrates a dialog box 22 in which the user selects with an input device one or more target printers 8a, b, c, d and/or a printer file. To select a target file, the user may enter a printer file name in the file name box 23 to create a target file to receive the source values. After selecting a source printer 8a, b, c, d or file and target printers 8a, b, c, d and/or a printer file, the dialog box 24 shown in FIG. 4 is displayed on the monitor 6a, b, c, d. The dialog box 24 lists groups of features 26 available in the source printer 8a, b, c, d or printer file. A user would select the features from the displayed groups of source features 26. The values for the selected features would be copied to the target printers 8a, b, c, d and/or printer file.

"FIG. 5 illustrates a dialog box 28 displayed on the monitor 6a, b, c, d after features from the displayed group of features 26 are selected in dialog box 24. This dialog box 28 shows the selected source printer or file, target printers 8a, b, c, d, and/or target printer file. In preferred embodiments, the dialog box 28 may also display the value set in the source for each selected source feature to copy. For instance, in FIG. 5, the user selected the console lock feature to copy the value for the console lock feature at the source to the target. The dialog box 28 displays the current value for the console lock setting in the source printer "Office," which in the example of FIG. 5 is false." Boldt, column 6, lines 38-63.

* * *

"targets will unlock the console in those target printers 8a, b, c, d and/or printer file capable of console locking.

"The user may select the 'Finish' button to invoke the process of copying the values for the selected features and configurations to the target printers 8a, b, c, d and/or printer file. Upon selecting 'Finish' in the dialog box 28, the dialog box 30 illustrated in FIG. 6 is displayed on the monitor 6a, b, c, d. This shows the target printer 8a, b, c, d and/or file to which the values are currently being applied, which in the displayed example is the printer named 'Printer room.' The dialog box 30 may also display target printers and/or a printer file previously configured with the values from the source. After the values from the selected source features are applied to all the target printers and/or printer file, the dialog box 32 illustrated in FIG. 7 is displayed showing the results of copying the values form the source to the target. This dialog box 32 shows which values failed to copy over successfully. For instance, the value for the console lock feature was not copied from the source printer "Office" to the target printer 'Printer room' as the console lock feature is not an available feature on the target printer 'Printer room,' i.e., one cannot lock the

console of the printer 'Printer room.' All values for the selected source
features were successfully applied to the printer file named 'OfficeFile2.'
In preferred embodiments, all values will successfully copy to a target
printer file, which merely stores values for subsequent use." Boldt,
column 7, lines 1-27.

Boldt teaches copying configuration settings from one printer to another over a
network. Example configuration settings disclosed in Boldt include setting whether the
printer runs in duplex mode, console lock settings, toner density settings, print quality,
power save delay, and localization settings. (See Boldt, column 3, line 60 – column 6,
line 19.) So far as Applicants can determine, there is nothing in these configuration
settings that teaches or suggests creating a printer menu structure or installing the
printer menu structure on the printer as recited in Claim 1.

To establish a prima facie case of obviousness, the Examiner carries the burden
of showing that the cited references teach or suggest all limitations in the claims. For
the reasons noted above, the Examiner has so far failed to meet this burden.
Accordingly, the rejection of Claim 1 and 16 and their respective dependent claims
should be withdrawn.

**B.   Ground For Rejection B (Claims 11-15) – Boldt does not teach a printer
         having a data communication interface coupled to the printer display
         panel to allow the printer to receive a printer menu structure from a
         remote device.**

Claims 1-10 and 16-20 were rejected under Section 103 as being obvious over
Boldt (6349304) in view of Hanson (6148346). The rejection is based on the assertion
that Boldt teaches a data communication interface coupled to the printer display panel
to allow the printer to receive a printer menu structure from a remote device.
Applicants respectfully submit that this assertion is not correct.

Claim 11 recites a printer having a data communication interface coupled to the
printer display panel to allow the printer to receive a printer menu structure from a
remote device. The Examiner argues that Boldt discloses such a data communication
interface at column 6, lines 34-38. The passage in Boldt relied on by the Examiner is
quoted verbatim below – there is nothing apparent in this passage that teaches or
suggests a data communication interface configured to allow the printer to receive a
printer menu structure from a remote device. A printer menu is not even mentioned.

"The printer file is a data file stored in a storage area of the computer 4a,
b, c, d. Printer files are created to store various printer settings. The user
can then apply the printer file to a printer 8a, b, c, d to configure the
printer 8a, b, c, d according to the settings maintained in the printer file."
Boldt, column 6, lines 34-38.

As noted above, Boldt teaches copying configuration settings from one printer to
another over a network. Example configuration settings disclosed in Boldt include
setting whether the printer runs in duplex mode, console lock settings, toner density
settings, print quality, power save delay, and localization settings. (See Boldt, column
3, line 60 – column 6, line 19.) There is nothing in these configuration settings that
teaches or suggests creating a printer menu structure, installing the printer menu
structure on the printer or a communication interface configured to allow the printer to
receive the printer menu structure from a remote device.

To establish a prima facie case of obviousness, the Examiner carries the
burden of showing that the cited references teach or suggest all limitations in the
claims. For the reasons noted above, the Examiner has so far failed to meet this
burden. Accordingly, the rejection of Claim 11 and its respective dependent claims
should be withdrawn.

**C.   Ground For Rejection C (Claims 2, 3 and 17) -- Hanson does not teach that
installing the printer menu structure replaces any menu structure
previously installed on the printer (Claims 2 and 17) or installing the
printer menu structure extends any menu structure previously installed on
the printer (Claim 3).**

Claim 2 depends from Claim 1 and adds the further limitation that installing the
printer menu structure replaces any menu structure previously installed on the printer.
Claim 17 is a programming counterpart to method Claim 2 and recites a similar added
limitation. The Examiner argues that Hanson discloses the further limitation of Claim 2
at column 8, lines 29-44. The passage in Hanson relied on by the Examiner is quoted
verbatim below -- there is nothing apparent in this passage that teaches or suggests
replacing a menu structure previously installed on the printer.

"The system then allows the user to change settings by selection of
various graphically displayed peripheral specific data object options within
the GUI objects 52 at 112. If the user decides no changes are necessary,
the system exits the GUI objects at 114. However, if the user makes

changes at 116, but is dissatisfied with the changes at 118 the user can alter any changes made. If the user is satisfied with the changes, the data channel 58 stores peripheral specific data object changes in the peripheral device 56 at 120 and the peripheral specific data object changes are implemented in OS specific code at 122 by the OS specific portion 33. Lastly, the OS specific portion 33 passes the peripheral specific data object changes implemented in OS specific code to the application software 32." Hanson, column 8, lines 29-44.

Hanson teaches a device driver system that provides for communication between peripheral devices and one or more operating systems via a network. In particular, Hanson "incorporates object oriented programs to create a single device driver that provides communication between any host computer system and any peripheral device." Col. 4, lines 7-9. Thus, the Hanson reference is directed toward device drivers that provide communication between hosts and peripheral devices. Although Hanson mentions the ability to change settings on peripheral devices, Hanson fails to disclose or suggest anything even remotely related to replacing a menu structure previously installed on the printer. For this additional reason, Claims 2 and 17 are allowable over the combination of Boldt and Hanson.

Claim 3 depends from Claim 1 and adds the further limitation that installing the printer menu structure extends any menu structure previously installed on the printer. The Examiner argues that Hanson discloses the further limitation of Claim 3 at Fig. 8e and column 6, lines 45-53. The passage in Hanson relied on by the Examiner is quoted verbatim below — there is nothing apparent in this passage that teaches or suggests extending a menu structure previously installed on the printer.

"FIG. 8E illustrates recent user statistics display 82a of the printer accessed through the 'examine user statistics' button 82 of the administrative maintenance menu 74. The user statistics display 82a of the present invention illustrates the name of the person and pages printed in the last ten episodes performed on the printer. Other information relating to previous episodes may also be displayed." Hanson, column 6, lines 45-53.

As noted above, Hanson teaches a device driver system that provides for communication between peripheral devices and one or more operating systems via a network. Although Hanson mentions the ability to change settings on peripheral devices, Hanson fails to disclose or suggest anything even remotely related to

extending a menu structure previously installed on the printer. For this additional reason, Claim 3 is allowable over the combination of Boldt and Hanson.

Respectfully submitted,

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APPENDIX OF CLAIMS INVOLVED IN THE APPEAL

1.   A method of configuring a printer, the method comprising:

creating a printer menu structure; and

installing the printer menu structure on the printer, wherein the printer menu structure is installed on an erasable storage device in the printer.

2.   A method as recited in claim 1 wherein installing the printer menu structure replaces any menu structure previously installed on the printer.

3.   A method as recited in claim 1 wherein installing the printer menu structure extends any menu structure previously installed on the printer.

4.   A method as recited in claim 1 further comprising simulating operation of the printer menu structure prior to installing the printer menu structure on the printer.

5.   A method as recited in claim 1 wherein creating a printer menu structure includes creating a hierarchy of menu elements.

6.   A method as recited in claim 5 wherein each menu element has an associated menu element type and an associated action.

7.   A method as recited in claim 1 wherein creating a printer menu structure includes associating an icon with at least one menu element in the printer menu structure.

8.   A method as recited in claim 1 wherein the method is performed by an end-user of the printer.

9.   A method as recited in claim 1 wherein creating a printer menu structure includes determining the arrangement of a plurality of menu elements on a printer display panel.

10.   A computer-readable memory containing a computer program that is executable by a processor to perform the method recited in claim 1.

11.   A printer comprising:

a display panel to display a plurality of menu elements;

a user interface coupled to the display panel to allow a user to select among the plurality of menu elements; and

a data communication interface coupled to the display panel to allow the printer to receive a printer menu structure from a remote device.

12.   An apparatus as recited in claim 11 wherein the data communication interface is a network interface.

13.   An apparatus as recited in claim 11 wherein the printer is a laser printer.

14.   An apparatus as recited in claim 11 wherein the user interface is a touch-sensitive screen positioned proximate the display panel.

15.   An apparatus as recited in claim 11 further comprising a memory device coupled to the data communication interface to store a printer menu structure received from the remote device.

16.   One or more computer-readable media having stored thereon a computer program comprising the following steps:

creating a printer menu structure; and

installing the printer menu structure on a printer, wherein the printer menu structure is installed on an erasable storage device in the printer.

17.   One or more computer-readable media as recited in claim 16 wherein installing the printer menu structure replaces any menu structure previously installed on the printer.

18.   One or more computer-readable media as recited in claim 16 further comprising simulating operation of the printer menu structure prior to installing the printer menu structure on the printer.

19.   One or more computer-readable media as recited in claim 16 wherein creating a printer menu structure includes creating a hierarchy of menu elements.

20.   One or more computer-readable media as recited in claim 16 wherein creating a printer menu structure includes creating a hierarchy of menu elements, and each menu element has an associated menu element type and an associated action.